

**REMARKS**

Applicant appreciates the attention of the Examiner to the application. The Office Action of the Examiner of February 10, 2006 has been reviewed with care in the preparation of this response. The amendment above and the following remarks are believed to be fully responsive to this action.

**Status of Claims**

Claims 1-5, 7-27, and 29-52, as presented by the above amendment, are pending. The pending claims set forth a novel and non-obvious aerial work apparatus. Claims 3, 5, 15-19, 25, 26, 32-35, 39, 40 and 45-47 have been previously withdrawn from consideration in response to an election of species requirement. Claims 36-38 and 41-44 have also been previously withdrawn in response to a restriction requirement and remain withdrawn with traverse. Allowance of all pending claims is respectfully requested in view of the above amendment and the following remarks.

Claims 1, 2, 4, 20, 21 and 48 were rejected under 35 U.S.C. §103(a) as being unpatentable over Inokuchi et al. (U.S. Patent No. 6,325,749) in view of Abbott (U.S. Patent No. 4,360,077). Claims 22 - 24 were rejected under 35 U.S.C. §103(a) as being unpatentable over Inokuchi and Abbott as applied to claim 21 and further in view of Peterson et al. (U.S. Patent No. 5,431,526). (Claim 23 was missing from the rejection of claims 22 and 24 on page 3 of the office action but was presumed inadvertently left out given the remarks made by the Examiner.) Claim 48 was further rejected under 35 U.S.C. §103(a) as being unpatentable over Woodling (U.S. Patent No. 5,727,645) in view of Abbott. Claim 49 was rejected under 35 U.S.C. §103(a) as being unpatentable over Woodling and Abbott as applied to claim 48 and further in view of Logan et al. (U.S. Patent No. 4,744,718). Claims 6-8, 28-30 and 51 were rejected under 35 U.S.C. §103(a) as being unpatentable over Woodling in view of Logan, Abbott, and Shammout (U.S. Patent No. 5,116,189). Claims 9 and 50 were rejected under 35 U.S.C. §103(a) as being unpatentable over Woodling, Logan and Abbott, as applied above, and further in view of Inokuchi as applied to claim 2. Claims 10-12 were rejected under 35 U.S.C. §103(a) as being

unpatentable over Woodling, Logan, Abbott and Inokuchi as applied to claim 9 and further in view of Peterson as applied above. Claim 27 was rejected under 35 U.S.C. §103(a) as being unpatentable over Inokuchi in view of Shammout as applied above. Claims 14 and 31 were rejected as being unpatentable over Woodling, Logan, Abbott and Inokuchi, as applied above, and further in view of Shammout as applied above. Claims 6, 7, 20, 28, 29, 48 and 49 were rejected under 35 U.S.C. §103(a) as being unpatentable over Sterner (U.S. Patent No. 4,657,109) in view of Abbott. Claims 8, 31 and 51 were rejected under 35 U.S.C. §103(a) as being unpatentable over Sterner and Abbott, as applied above, and further in view of Shammout as applied above. Claim 13 was objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form. Claim 20 was rejected under 35 U.S.C. §112 ¶ 2 as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention.

Applicant has prepared and hereby submits the above amendment to the claims. Claims 1, 7, 20 and 29 have been amended. Claims 6 and 28 have been cancelled. Claim 52 has been added. Claim 52 is readable upon elected Species I and Invention I. The amendment is fully supported by the specification to the application and does not include any new matter. Applicant appreciates the indication of allowable subject matter in claim 13. The claims as amended, including new claim 52, are patentably distinguishable over the prior art and the references cited by the Examiner in particular.

Applicant now turns to the particular points raised by the Examiner in the Office Action of February 10, 2006.

Rejection of Claim 20 under 35 U.S.C. §112, ¶ 2

Claim 20 was rejected under 35 U.S.C. §112, ¶ 2 as being unclear in its use of the phrase “the platform being mounted with respect to the platform.” The platform control module and not the platform is mounted with respect to the platform. Claim 20 has been amended to address the lack of clarity in the claim as previously presented. This correction Applicant asks therefore that the rejection of claim 20 on the basis of 35 U.S.C. §112, ¶ 2 be withdrawn.

Rejection of Claims 1, 20 and 48 under 35 U.S.C. §103(a)

Independent claims 1, 20 and 48 were rejected under 35 U.S.C. §103(a) as being unpatentable over Inokuchi in view of Abbott. Claim 48 was also rejected as being unpatentable over Woodling in view of Abbott. Applicant respectfully traverses the rejection of amended claim 1, amended claim 20, and claim 48 as well as any claims dependent to them, requesting that each of these rejections be withdrawn.

The Examiner acknowledges that Inokuchi and Woodling do not disclose an aerial work apparatus having a platform control module mounted with respect to an aerial work platform. He points to Abbott as teaching a platform control module. The Examiner merely states that it would have been obvious to one of ordinary skill in the art to provide the platform of Inokuchi or Woodling with the platform control module in Abbott to control the position of the platform and the vehicle on which the boom supporting the platform is mounted.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Jones, 958 F.2d 347 (Fed. Cir. 1992). In particular, there must be more of a justification for combining references or modifying them than solely the fact that such pieces of prior art happened to have been known at the time of the invention. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination or modification. MPEP §2143.01.

For these reasons, a specific explanation why a skilled artisan would have been motivated to make a claimed modification must be set forth by an examiner after any rejection under 35 U.S.C. §103. MPEP §706.02(j). There is no showing in the present Office Action, however, of any reasons or motivation within Inokuchi, Woodling or Abbott to support the combination and modification of the Inokuchi or Woodling apparatus to include the Abbott control module that the Examiner is relying upon for his rejections of claims 1, 20 and 48.

The requirement of a specific explanation arises in part because of the type of hindsight that can often occur when the initial disclosure is by Applicant of his invention. “To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” In re Rouffet, 149 F. 3d 1350 at 1357-1358; 47 USPQ 2d 1453 (Fed. Cir. 1998).

For the Examiner to simply call upon the supposed level of skill of one skilled in the art to provide the necessary motivation for the selection of Inokuchi or Woodling and Abbott is not the showing required under the MPEP but rather an exercise in the very hindsight frowned upon by the courts. While it is true that an examiner may base an obviousness rejection upon common knowledge in the art, this is the case only if such a teaching is capable of being instantly and unquestionably demonstrated as being clearly “well-known” in the art. MPEP §2144.03. Whether or not the Examiner relies upon such a teaching for the suggestion to make the very modification to the bucket in Inokuchi needed to arrive at the claimed aerial work platform, however, is left unanswered and unsupported in the present Office Action. Applicant therefore demands that the Examiner provide specific authority if an assertion of common knowledge is being relied upon by him to support the obviousness rejections in question.

In addition, claims 1 and 20, as amended, include the limitation that the platform include a rail support frame attached to the boom defining a boom side and an outer side and having at least one substantially horizontal rail. The platform also includes a work basket removably mounted to the rail support frame and supported upon the rail where the rail support frame is adapted to receive the work basket on either the boom side or outer side. This limitation is not taught or suggested by either Inokuchi or Abbott.

Certain elements of this limitation had been set forth in claims 6 and 28, now cancelled, and in claim 49. Claims 6 and 28 had been rejected under 35 U.S.C. §103(a) as being unpatentable over Woodling in view of Logan, Abbott and Shammout and claim 49 has been

rejected as being unpatentable over Woodling and Abbott as applied to claim 48 in view of Logan. The Examiner acknowledges that Woodling does not disclose an aerial work apparatus having a work basket removably mounted to a rail support frame. Abbott and Shammout do not disclose such features and the Office Action does not suggest that they do. The Examiner points rather to Logan as providing a rail support frame. No rail support frame is, however, taught or suggested by Logan.

Logan discloses an attachment plate at the free end of its boom that is arranged to have a variety of different service facilities attached to it. (Logan at col. 3, lines 29-37). Nothing more is said in the reference with respect to the structure of this plate. Certainly nothing is set forth to suggest that the plate in question includes a substantially horizontal rail extending from its first and second ends or that it is adapted to receive a work basket on either its boom side or its outer side. While a substantially vertical framing section 60 is shown to be connected to the plate in an abutting manner along its outer face and a channel 61 is seen positioned upon the upper edge of section 60, this still falls short of satisfying each of the requirements of amended claims 1 and 20.

In addition, Woodling teaches against modifying triangularly-shaped connector 84 as suggested by the Examiner. To do so would create a connector at the end of the boom structure that would be unable to have the personnel basket 72 mounted to it in the manner desired. Connector 84 is adapted to be received by diagonally diverging connector brackets 96,98 mounted on the inner end of basket 72. (Woodling at col. 3, lines 29-38). To attach basket 72 to the aerial lift in Woodling, connector 84 needs only to be placed beneath brackets 96,98 on the basket so that it can be raised mechanically upward with respect to the basket by operation of only the boom and guided into engagement with locking pin 100 by the brackets. The combination and changes suggested by the Examiner would therefore clearly make the aerial lift in Woodling highly unsatisfactory for its intended purposes.

The lack of any explanation by the Examiner of the motivation for one skilled in the art to select and then modify the references cited, absent impermissible hindsight, along with the other reasons discussed above, establishes that a *prima facie* case of obviousness has not been made to maintain the rejection of claims 1, 20, 48 and 49, as amended. Applicant believes that this

rejection should be withdrawn and that these claims, in addition to claims 2-5, 7-19, 21-27, 29-35, and 50-52 that are dependent to them, be allowed.

Rejection of Claims 2 and 21 under 35 U.S.C. §103(a)

Claims 2 and 21 were also rejected under 35 U.S.C. §103(a) as being unpatentable over Inokuchi in view of Abbott. Both claims add the limitation that the material-handling device be a dual winch device having first and second winch assemblies and a winch control module. Neither reference teaches or suggests this element. The Examiner states, however, that it would have been obvious to one of ordinary skill in the art to duplicate the teaching of a single winch device 10 in Inokuchi by providing a second winch device to enable dual lifting.

There is no showing in the present Office Action of any reasons or motivation within Inokuchi to support the modification the Examiner relies upon for his rejection of claims 2 and 21. The Examiner simply calls upon the supposed level of skill of one skilled in the art to provide the necessary motivation for the selection and modification of Inokuchi. This is not the showing required under the MPEP but rather an exercise in hindsight frowned upon by the courts. Moreover, the Examiner fails to even explain what the specific understanding or technological principle within the knowledge of a skilled artisan is that would have suggested to such an individual to make the very modification to the bucket in Inokuchi needed to arrive at the claimed aerial work platform.

In addition, Inokuchi teaches against modifying the bucket in the manner suggested. To do so would create a bucket that would lose its ability to work on hot-lines in a compact and lightweight manner. (Inokuchi at col.1, lines 19-42 and at col. 3, lines 58-65). Highly accurate positioning and working of a heavy object suspended from the suspender arm 10 is achieved with both of the two-armed manipulators 5, 6 that are already mounted on the bucket. Moreover, the limited space on the bucket is already compromised by the presence of a number of other pieces of equipment that include an automatic tool changer 8 and automatic material exchanger 9. (Inokuchi at col.8, line 56 to col. 9, line 5). Nowhere in Inokuchi is there a teaching that adding another suspender arm is, in any way, needed or desirable. The modification proposed by the

Examiner would make the apparatus in Inokuchi highly unsatisfactory for its obviously intended purposes.

For each of the reasons discussed above, Applicant believes that rejection of claims 2 and 21 should be withdrawn and that these claims, in addition to claims 22 and 24 that are dependent to claim 21, should be allowed.

Rejection of Claim 8 under 35 U.S.C. §103(a)

Claim 8 was rejected under 35 U.S.C. §103(a) as being unpatentable over Woodling in view of Logan and Abbott as applied to claims 6 and 7 and further in view of Shammout. Claim 8 adds the requirement that the material-handling device be at least two material support feet slidably attached to the front basket such that the feet are free to extend outward in front of the basket. This claim is not rendered obvious by these references but is instead patentably distinguishable over such prior art.

Neither Woodling, Logan, Abbott or Shammout teach the limitation in question. The guide bars 34, 36 and guide slots 38, 40 in Shammout are referred to by the Examiner as disclosing material support feet. These structures are, however, secured to platform 18 for raising and lowering the platform beneath lift bucket 12. (Shammout at col. 4, lines 10-59). These “material support feet” therefore do not extend outward in front of the lift bucket. For these additional reasons, Applicant requests that the specific rejection of claim 8 be withdrawn.

Rejection of Claims 9, 30, and 50 under 35 U.S.C. §103(a)

Claims 9 and 50 were rejected under 35 U.S.C. §103(a) as being unpatentable over Woodling, Logan and Abbott as applied to their base claims and further in view of Inokuchi. Claim 30 had been rejected on the same basis as claim 8. This is presumed by Applicant to be in error since all three of these claims include the same added limitation as claim 2 that had been rejected in view of Inokuchi as modified. The rejection of claim 30 will therefore be traversed on the basis of the rejections of claims 9 and 50.

For the same reasons stated earlier with respect to the patentability of claim 2, there is also no showing in the Office Action of a motivation to modify the apparatus in Inokuchi to include first and second winch assemblies. Applicant therefore believes that the rejection of claims 9, 30 and 50 has been traversed and that these claims as well as claims 10-14 that are dependent to claim 9 be allowed.

Rejection of Claims 12 and 23 under 35 U.S.C. §103(a)

Claim 12 was rejected under 35 U.S.C. §103(a) as being unpatentable over Woodling, Logan, Abbott and Inokuchi as applied to claim 9 and further in view of Peterson. Claim 23 was rejected under 35 U.S.C. §103(a) as being unpatentable over Inokuchi and Abbott as applied to claim 21 and further in view of Peterson. Each claim is allowable at least by virtue of its dependency from a claim traversing any rejection by the Examiner as set forth above. In addition, however, both claims include a limitation that the first and second winch assemblies be mounted at opposite ends of the rail support frame. This feature is neither taught nor suggested by any of the references cited.

There is also no showing in the present Office Action of any reasons or motivation within Woodling, Logan, Abbott, Inokuchi or Peterson to support the combination and modification relied upon by the Examiner for the rejection of these claims. The Examiner acknowledges the absence of any teaching of the limitation in question by stating that attaching winch assemblies on opposite sides of a platform to provide balancing of the platform would be an obvious engineering expediency. For the Examiner to simply call upon the subjective basis of engineering expediency to provide the necessary motivation for the selection and modification of the references he relies upon is once again not the specific and objective explanation required to be set forth under MPEP §706.02(j) but rather, at best, an exercise in hindsight. Pursuant to MPEP §2144.03, Applicant traverses such a finding and demands that the Examiner provide specific authority to support his assertion with adequate evidence in order to establish that a *prima facie* case of obviousness has been made to maintain the rejection of both claims.

An examiner may not simply select from the prior art the separate components of the claimed invention through the use of the blueprint supplied by the inventor. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985). The act of identifying the various elements of the claimed invention in the prior art without there being any teaching, suggestion or motivation for their combination is not the legal test of obviousness. It is, after all, well recognized that most, if not all, inventions are no more than combinations of old elements in the prior art. Environmental Designs, Ltd. V. Union Oil Co., 713 F. 2d 693, 218 USPQ 865 (Fed. Cir. 1983); Richdel, Inc. V. Sunspool Corp., 714 F. 2d 1573, 219 USPQ 8 (Fed. Cir. 1983). “If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be ‘an illogical and inappropriate process by which to determine patentability.’ Sensonics, Inc. v. Aerosonic Corp., 81 F. 3d 1566, 1570, 38 USPQ 2d 1551, 1554 (Fed. Cir. 1996).” In re Rouffet, 47 USPQ 2d at 1457 (Fed. Cir. 1998).

Moreover, Woodling teaches against modifying its personnel basket and Inokuchi teaches against modifying its bucket in the manner suggested by the Examiner. Woodling teaches an aerial lift with a removable basket already having a winch device as shown by winch cable 26 extending over sheave 34. There is no suggestion in Woodling as would motivate one skilled in the art to make superfluous the existing winch by the addition of two more winch assemblies. In addition, the supposed “rail support frame” in Woodling, a simple triangular-shaped piece 84 at the upper end of the boom 18, is entirely inadequate to support a dual winch device. Even if this structure could be fitted with two winch assemblies, it would defeat its intended purpose since the basket would no longer be able to be mounted over it.

Likewise, as explained above with respect to the allowance of claim 2, the proposed underlying modification of Inokuchi would create a bucket that has lost its ability to work on hot-lines in a compact and lightweight manner. The combination and changes suggested by the Examiner would make the apparatus in Inokuchi highly unsatisfactory for its intended purposes.

For each of these specific reasons, Applicant asks that claims 12 and 23, as well as any claims that depend from them, be allowed.

Rejection of Claims 14, 27 and 31 under 35 U.S.C. §103(a)

Claim 27 was rejected under 35 U.S.C. §103(a) as being unpatentable over Inokuchi in view of Shammout. Claims 14 and 31 were rejected under 35 U.S.C. §103(a) as being unpatentable over Woodling, Logan, Abbott and Inokuchi as applied to their base claims and further in view of Shammout.

Each claim is allowable at least by virtue of its dependency from a claim overcoming any rejection by the Examiner. In addition, however, each claim includes the limitation that there are at least two material support feet slidably attached to the platform (claim 27) or front basket (claims 14 and 31) such that the feet are free to extend outward in front of the platform or basket respectively. This limitation is not taught by Woodling, Logan, Abbott, Inokuchi or Shammout. As stated with respect to the allowance of claim 8, the supposed “material support feet” disclosed in Shammout are secured to a platform for raising and lowering this platform beneath the device’s lift bucket. Since these structures do not extend outward in front of the lift bucket, Applicant requests that the specific rejections of claims 14, 27 and 31 also be withdrawn and that these claims be allowed.

Further Rejection of Claims 6, 7, 20, 28, 29, 48 and 49 under 35 U.S.C. §103(a)

Claims 6, 7, 20, 28, 29, 48 and 49 were also rejected under 35 U.S.C. §103(a) as being unpatentable over Sterner in view of Abbott. Claims 6 and 28 have been cancelled. Applicant respectfully traverses the rejection of claims 7, 20, 29, 48 and 49, as amended, as well as any claims dependent to them.

The Examiner states that Sterner discloses an aerial work apparatus as set forth in these claims with the exception of a platform control module mounted with respect to the aerial work platform. He then points to Abbott as teaching a platform control module. The Examiner merely

states that it would have been obvious to one of ordinary skill in the art to provide the platform of Sterner with the platform control module in Abbott to control the position of the platform and the vehicle on which the boom supporting the platform is mounted.

There are, however, features in addition to the platform control module set forth in these claims that are not taught or suggested by either Sterner or Abbott. Sterner merely discloses a worker supporting basket 40 that is suspended downward pendulum-like from a shaft 39 extending between lateral members 33 on support base 24. The Examiner points in the Office Action to only the horizontal shaft 39 as supporting basket 40 but not to any structure that he states discloses a rail support frame as required by claims 7, 20, 29 and 49. Certainly no rail support frame is taught or suggested in Sterner that defines a boom side and an outer side or is adapted so as to receive a work basket on either of these sides, much less a work platform that comprises such a rail support frame and to which at least one material-handling device is mounted.

Moreover, no specific explanation why a skilled artisan would have been motivated to make the claimed modification is set forth by the Examiner as required by MPEP §706.02(j). There is no showing in the present Office Action of any reasons or motivation within Sterner or Abbott to support the combination and modification of the Sterner apparatus to include the Abbott control module that the Examiner is relying upon for his rejection of each of these claims. For the Examiner to simply call upon the supposed level of skill of one skilled in the art to provide the necessary motivation for the selection of Sterner and Abbott is not the showing required under the MPEP but rather an exercise in hindsight frowned upon by the courts.

For each of these reasons, a *prima facie* case of obviousness has not been made to maintain the rejection of claims 7, 20, 29, 48 and 49, as amended. Applicant believes that this rejection should be withdrawn and that these claims, in addition to any claims that are dependent to them, be allowed.

Rejection of Claims 8, 31 and 51 under 35 U.S.C. §103(a)

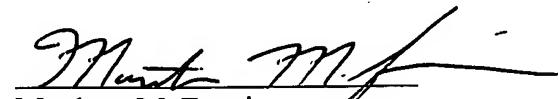
Claims 8, 31 and 51 were rejected under 35 U.S.C. §103(a) as being unpatentable over Sterner and Abbott, as applied above, and further in view of Shammout. Each adds at least the limitation that the material-handling device be at least two material support feet slidably attached to the front basket such that the feet are free to extend outward in front of the basket. As stated previously with respect to the allowance of claims 8, 14, 27 and 31, the supposed “material support feet” disclosed in Shammout are secured to a platform for raising and lowering this platform beneath the device’s lift bucket. Since these structures do not extend outward in front of the lift bucket, Applicant believes that these rejections of claims 8, 31 and 51 have also been traversed and that these claims should now be allowed.

Conclusion

Applicant’s invention, as set forth in the amended claims, represents a novel and non-obvious aerial work apparatus. Applicant believes that the now pending claims 1-5, 7-27, and 29-52 have elements not disclosed or suggested in the prior art. Applicant respectfully submits that all rejections in the Office Action have been traversed by amendment and argument, placing the application in condition for allowance. In addition, newly added claim 52 is patentably distinguishable over the prior art cited and allowable at least by virtue of its dependency from amended claim 1.

Early favorable action is earnestly solicited. The Examiner is invited to call the undersigned if such would be helpful in resolving any issue which might remain. Please debit Deposit Account 10-0270 for a three-month extension fee. If any additional fees are due please debit Deposit Account 10-0270 and inform the undersigned.

Respectfully submitted,

  
Matthew M. Fannin  
Registration No. 51,268

Dated: August 10, 2006

Jansson, Shupe & Munger, Ltd.  
245 Main Street  
Racine, WI 53403-1034  
Attorney Docket No. MLE-101US  
Telephone: 262/632-6900  
Telefax: 262/632-2257